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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/689,550      | 10/21/2003  | Pnina Fishman        | FISHMAN10A          | 9316             |

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BROWDY AND NEIMARK, P.L.L.C.  
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WASHINGTON, DC 20001-5303

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| EXAMINER |
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SANG, HONG

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| ART UNIT | PAPER NUMBER |
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1643

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| MAIL DATE | DELIVERY MODE |
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04/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                               |                                |  |
|---|-------------------------------|--------------------------------|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | Application No.<br>10/689,550 | Applicant(s)<br>FISHMAN ET AL. |  |
|   | Examiner<br>Hong Sang         | Art Unit<br>1643               |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 15 March 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): 35 U.S.C. 112, 1<sup>st</sup> enablement rejection.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 2, 5, 7, 10, 12, 13, 16 and 17.

Claim(s) withdrawn from consideration: 14 and 15.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see continuation sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

Continuation of 11. does NOT place the application in condition for allowance because: applicant's arguments are not deemed persuasive to overcome the rejections of record. Specifically, applicant argues that the methods of Baraldi are not for determining the presence of tumor cells, they are for determining the presence of tumor cells that possess a high concentration of adenosine A3 receptors. The response states that the methods of Baraldi are based on experiments relating to tumor cell lines and some human cell lines have high concentrations of A3AR does not establish that a natural human tumor will have a higher level of A3AR expression than control cells from the same patient. The response states that there is nothing in Baraldi that would suggest that the higher the amount of A3AR the more severe is the disease state, and that the higher A3AR level is more or less likely to be treatable by an A3AR agonist or antagonist. Applicants' arguments have been carefully considered but are not found persuasive. As indicated in the previous office action, Baraldi et al. claim a method of detecting tumor cells which possess a high concentration of A3AR receptors in a patient and in a cell sample. While Baraldi et al. do not specifically teach that the higher the amount of A3AR the more severe is the disease state, and the higher A3AR level is more or less likely to be treatable by an A3AR agonist or antagonist, because the active steps of the instant claims only recite detecting the level of A3AR in tumor cells and comparing the level of said A3AR expression in tumor cells to a control level, the control level being the level of A3AR expression in normal cells of the same subject, or being a standard reference level for the A3AR expression which is indicative of normal, the combination of the cited reference teach all the active steps of the claims. Therefore, the rejection is deemed proper and is maintained.

Hong Sang, Ph.D.  
Art Unit 1643  
March 23, 2007

  
CHRISTOPHER H. YAEN  
PRIMARY EXAMINER